UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,133	05/31/2001	Joshua Robert Nemeth	EL599431223U	9545

7590 09/27/2002

Christensen O'Connor Johnson & Kindness
Suite 2800
1420 Fifth Avenue
Seattle, WA 98101-2347

EXAMINER	
NGUYEN, KIMBERLY T	
ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N . 09/857,133	Applicant(s) NEMETH, JOSHUA ROBERT	
	Examiner Kimberly T. Nguyen	Art Unit 1774	

AS5

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-12 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Objections

Claims 5-12 are objected to under 37 CFR 1.75(c) as being in improper form because they depend on claims which are multiply dependent. Further, the phrase "to any preceding claim" is improper because it does not refer to claims in the alternative. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 4-10, Applicants show "A security document *or* other device." It is not clear what Applicant is specifically claiming.

In claim 1, the term "including" is not an appropriate transition term and thus, the scope of the claim is not clear.

The terms "substantially" and "partially" in claim 1 is a relative term which renders the claim indefinite. The terms "substantially" and "partially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

In claim 1, it is not clear how the ink can be both transparent/translucent and specular at the same time.

In claim 5, Applicant shows "The security document or device *of any preceding claim 4*." It is not clear which claims that claim 5 depends upon.

Claim 5 recites the limitation "the remainder of the security document or device." There is insufficient antecedent basis for this limitation in the claim.

In claim 9, the phrase "film of the *type* suitable for the production of banknotes" is unclear.

In claim 10, it is not clear what is meant by "the property of the ink produce an image having optical properties similar to the optical properties of tracing paper." It is not clear what the optical properties of the tracing paper is.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon et al., U.S. Pat. No. 5,762,379.

Salmon shows a printed article comprising a plastic board stock, a film of reflective foil material applied to the board stock, and printing a raised image comprising translucent ink onto the reflective foil material (claims 1 and 21) about 0.1 mil in thickness (column 3, lines 9-19). Salmon shows that the thickness of the ink may be larger or smaller to suit particular applications and that the ink and reflective film may be applied by a silk screen method (column 3, lines 20-32 and column 5, lines 14-31).

Salmon does not show the gloss units, height of the printed image, and haze values as in instant claims 1-3 nor the thickness of the reflective layer as in instant claim 7. However, such ranges are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the ranges, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. ranges) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result effective as they control the level of reflectivity and three-dimensional effects and clarity of the image in the device. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device with the limitations of the ranges since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In claims 1, 4, and 8, the phrase "layer/foil applied to..." introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113.* Further, process limitations are given no patentable weight in product claims.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Salmon et al., U.S. Pat. No. 5,762,379 in further in view of Philips et al., U.S. Pat. No. 5,766,738.

Salmon is relied upon as above for claims 1-5. Salmon does not show a gravure printing process as in instant claim 6. Philips shows an optically variable article comprising a substrate, foil layer, and ink layers wherein the ink is applied by an intaglio or gravure or silk screening printing process (column 21, lines 1-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ an intaglio or gravure printing process since it is known that such a process is effective for printing inks and reflective materials onto foil surfaces and/or polymer substrates and because intaglio, gravure, and silk-screening processes are functional equivalents for applying inks and reflective material.

Claims 4-6 are rejected because they are product-by-process claims. Additionally, the terms "is applied to...by a printing process" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113.*

In claims 1 and 4, the phrase "layer/foil applied to..." introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113.* Further, process limitations are given no patentable weight in product claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
September 16, 2002

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700